

invention must be considered as a whole; 2) the references must be considered as a whole and must suggest the desirability and, thus, the obviousness, of making the combination; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187, n.5 (Fed. Cir. 1986). All of the claim limitations must be taught in order to establish obviousness. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Further, an obviousness rejection is improper if substantial redesign of the prior art is required to support the rejection. *In re Ratti*, 270 F.2d 810 (C.C.P.A. 1959).

Appelbaum discloses a ring with an interchangeable setting 18 that is held in place on a bridge 28 when a latch 50 is closed. However, the latch is integrally connected to the setting by a pin 52. As admitted by the Examiner, Appelbaum neither discloses nor suggests the use of an independent module discrete from the setting as required in independent claims 1, 6, and 25. The Examiner improperly alleges that the use of a discrete module is simply an obvious design choice over Appelbaum. The latch taught by Appelbaum is integral with the setting and would not properly function if it were independent from the setting. Specifically, the latch is hingedly connected to the setting at a first end via a pin while the second end of the latch comprises a resilient arm 60 that clamps onto the bridge and setting. Thus, the pin would have to be removed in order for the latch to be discrete from the setting, but without the pin, the first end of the disclosed latch of Appelbaum could not connect to the setting and thus, could not properly retain the setting. Further, the resilient arm would not properly retain the connection unless the first end is previously fixed to the setting. Thus, substantial redesign of the disclosed latch would be necessary in order for the latch to be discrete from the setting. As discussed above, an obviousness rejection is improper if substantial redesign is required to support the rejection. *In re Ratti*, 270 F.2d 810 (C.C.P.A. 1959).

Additionally, Applicant respectfully traverses the rejection of claim 1, 6, and 25 as the Examiner has improperly relied solely on case law in support of the rejection. “If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law to support an obviousness rejection.” MPEP § 2144.04. The specification clearly

Serial No.: 10/649,309
Confirmation No.: 5404
Applicant: Ronald W. Hartgrove
Atty. Ref.: 11149.0030.NPUS00

indicates that the capture module is discrete from the setting. In fact, the specification states that “the module, like the setting, can be interchangeable.” (Para. 004, l. 10) Further, each and every claim requires that the “capture module” or the means for preventing the removal of the setting be discrete from the setting itself.

For at least these reasons, Applicant respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of independent claims 1, 6, and 25.

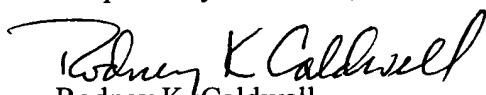
Claims 2–5, 7–24, and 26–30 depend from claims 1, 6, and 25 respectively and thus, incorporate each limitation therein. Therefore, claims 2–5, 7–24, and 26–30 are allowable for at least the same reason as independent claims 1, 6, and 25. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the § 103(a) rejection of claims 2–5, 7–24, and 26–30.

Given the above, Applicant requests that the rejection of claims 1–30 under 35 U.S.C. § 103(a) be reconsidered and withdrawn and that the Examiner indicate the allowance of the claims in the next paper from the Office.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. § 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 11149.0030.NPUS00.

The Examiner is invited to contact the undersigned representative by telephone to discuss any issues or questions raised by this paper.

Respectfully submitted,


Rodney K. Caldwell
Attorney for Applicant
Reg. No. 26,152
Tel. 713-787-1441
Date: May 27, 2005